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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,600	06/18/2001	Jeff M. Anderson	10011123-1	3353

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,600

Applicant(s)

ANDERSON ET AL.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/17/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to Amendment for Application Number 09/884,600 received on 19 September 2005.
2. Claims 1-24 are presented for examination.
3. Independent claims 1, 8, 15, and 22 have been amended.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8-10, 15-17, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prust (U.S. Patent Number 6,714,968) in view of Hussey (U.S. 5,826,269).

4. Regarding claims 1, 8, 15, and 22, Prust disclosed a document retrieval method comprising:

receiving a request email message from a requesting device via a network, the request email message embodying a document request (Prust, col. 7, lines 25-30);

automatically generating a response email message with at least one document attached thereto in response to the document request (Prust, col. 7, lines 30-35); and

However, Prust did not explicitly state determining from the request email address whether a destination address on the network to which at least one document specified in the document request is to be sent is a third party address or an originator address on the network, the originator address being associated with the requesting device; and

automatically generating a forwarding email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the third party address, the forwarding email message being addressed to the third party address; and

automatically transmitting either the forwarding email message to the third party address or the reply message to the originator address on the network in response to the request email message.

In an analogous art of email systems, Hussey disclosed an electronic interface for a network server in which clients send email requests and an email response builder generates a response email message, with an attached document, to be issued to the originator of the corresponding email address as well as any other "copied" email accounts originally designated in the "cc:" field (Hussey, col. 11, lines 55-67, col. 12, lines 1-10), which means a message with the requested document is sent to the requester as well as any other third party address specified in the "cc:" field.

Both Prust and Hussey provide emailing systems where users request data. Hussey goes into further detail of the standard functions of the emailing systems.

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate the basic functionalities of an email system as taught in Hussey into Prust to provide users with a system that processes user requests for shared resources administered by the server (Hussey, col. 3, lines 30-40).

5. Regarding claims 2, 3, 9, 10, 16, 17, 23, and 24, Prust and Hussey disclosed the limitations, substantially as claimed, as described in claims 1, 8, 15, and 22, including parsing the request email message to identify the destination address and the at least one document requested (Prust, col. 7, lines 25-35, Prust teaches when a file is requested, the user indicates where to locate that file in the email, and the server uses this location information to find the file and send it).

Claims 4, 11, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prust in view of Hussey as applied to claims 1-3, 8-10, 15-17, and 22-24, and further in view of Beerman, Jr. et al. (U.S. Patent Number 6,084,952).

6. Regarding claims 4, 11, and 18, Prust discloses the limitations, substantially as claimed, as described in claims 1, 8, and 15, including determining if the requesting device is authorized to retrieve the at least one document (Prust, col. 1, line3 37-43). However, Prust does not explicitly state automatically generating an access denial email message in response to the request email message when the requesting device is not authorized to retrieve the at least one document. In an analogous art of communicating electronic messages between a remote device and a server, Beerman teaches an

information processing subsystem which sends an email message to the unauthorized remote device user indicating authentication failure (Beerman, col. 9, lines 30-40).

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate sending authentication failure emails to users trying to request files in order to notify users of not being authorized of retrieval of documents.

Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prust in view of Cho. et al. (International Publication Number WO 01/33874).

7. Regarding claims 5, 12, and 19, Prust discloses the limitations, substantially as claimed, as described in claims 1, 8, and 15. However, Prust does not explicitly state receiving a request email message from a requesting device via a network, the request email message embodying a document request; automatically generating a response email message with at least one document attached thereto in response to the document request; and automatically transmitting the response email message to a destination address on the network. In an analogous art of remote file management, Cho discloses a file system directory structure viewing which makes it possible to view a directory listing of files belonging to the selected directory (Cho, page 7, lines 20-25). Cho also discloses the distribution manager transmitting files through email (Cho, page 6, lines 7-8). Prust and Cho are analogous because both inventions include remote file management where a user can access their stored files through email. Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention

to incorporate having access to directory listings to enable the user to choose from a list which file the user desires.

8. Regarding claims 6, 7, 13, 14, 20, and 21, Prust and Cho disclose the limitations, substantially as claimed, as described in claims 1, 5, 8, 12, 15, and 19. However, Prust and Cho do not explicitly state determining whether the request email message is properly formatted; and transmitting an error message to the requesting device when the request email message is not properly formatted. In an analogous art of networking, Nielsen discloses an email response process where an email is generated to respond to any format errors found from parsing the email for parameters (Nielsen, col. 5 line 63 through col. 6, line 13). Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate format error response system into the remote file and directory management system of Prust and Cho to provide the user with feedback in case of an error in the requesting email.

Response to Amendment

Applicant's arguments and amendments filed on 01 February 2005 have been carefully considered but they are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new grounds of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., *by incorporating new limitations into the independent claims, which will require further search and consideration*) to the claims which significantly affected the scope thereof.

Applicant's arguments with respect to claims 1-24 have been fully considered but they are not persuasive. Applicant's only argument with respect to the amended claims includes the failure of previously applied art to disclose "the concept of determining whether a response to a document request is to be transmitted to a third party address or an originator address on a network as claimed in claim 1."

In order for a web server to automatically send a response email, the web server must be able to determine what address/addresses should be used for the destination of the response. As shown in the above mapping of the independent claims Husset disclosed a web server determining where the response should be sent based on the contents of the requested email (Hussey, col. 7, lines 20-45). The determination is made as to which email address is the originator address (Hussey, col. 7, lines 25-26), and which addresses are the third party addresses (Hussey, col. 7, lines 27-30).

The claims as presented are not yet distinguished over the prior art. Examiner suggests reviewing the Response to Amendment in the Previous Office Action.

Applicant's arguments with respect to claims 1-24 are deemed moot in view of the following new grounds of rejection, necessitated by Applicant's amendment to the claims, which significantly affected the scope thereof.

Furthermore, as it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the

networking art as already shown by Hussey as well as other prior arts of records disclosed "requesting a document through email for multiple recipients" is taught as well as other claimed features of Applicant's invention. By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant.


Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.


In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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